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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,719	02/15/2005	Oskar Pacher	PACHER-2	8384
20151 7590 12/19/2008 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017			EXAMINER YANG, JIE	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 12/19/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,719	<b>Applicant(s)</b> PACHER ET AL.	
	<b>Examiner</b> JIE YANG	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-10 are pending in application.

#### ***Status of the Precious Rejection***

The previous rejection of claims 1-4, 7-9 under 35 U.S.C. 103(a) as being unpatentable over Koga et al (JP 2001-107195A, thereafter JP'195) is withdrawn in view of the applicant's remarks filled on 9/19/2008. However, upon further consideration, a new ground(s) of rejection is made based on a newly discovered reference.

The previous rejection of claims 5-6, and 10 under 35 U.S.C. 103(a) as being unpatentable over JP'195 as applied in claims 1-4, 7-9 and further in view of Baba (JP 60-213246, thereafter JP'246) is withdrawn in view of the applicant's remarks filed on 02/07/2008. However, upon further consideration, a new ground(s) of rejection is made based on a newly discovered reference.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board

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of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation of "a spring element", and the claim also recites: "in particular a spring rail for wipers" which is the narrower statement of the range/limitation. Proper correction is needed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okui et al (JP 2001-123248A, thereafter JP'248) in view of Ota et al (EP 1083237A2, thereafter EP'237).

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Regarding claims 1-3, JP'248 teaches a ferritic stainless steel sheet for a spring excellent in the spring characteristics (Abstract of JP'248). The comparisons of compositions between JP'248 and the instant invention are listed in following table. All the major composition ranges disclosed by JP'248 (Abstract and table 1 of JP'248) overlap or close to the composition ranges of the instant invention.

Element	From instant Claim 1 (in wt%)	JP'248 (in wt%)	Overlapping range (in wt%)
C	0.03-0.12	0-0.12	0.03-0.12
Cr	13-20	11-23	13-20
Si	0.2-0.9	1.0-3.5	--
Mn	0.3-1	0.1-2.0	0.3-1
Ni	0-0.5	0.2-4	0.2-0.5
Mo	0.1-2	--	--
Cu	0.05-1.0	0-0.8	0.05-0.8
N	0.02-0.5	0-0.12	0.02-0.12
Ti	0-0.01	0-0.1	0-0.01
Nb	0.01-1.0	0-0.1	0.01-0.1
V	0.02-0.25	--	--
Fe	Balance	Balance	Balance

JP'248 does not specify adding 0.1-2wt% Mo and 0.02-0.25wt% V in the alloy. EP'237 teaches a ferritic Cr-containing steel sheet having excellent ductility, formability, and anti-ridging properties (Abstract of EP'237). The comparisons of compositions between EP'237 and the instant invention are listed in following table. All the major composition ranges disclosed by EP'237 (Paragraphs [0040]-[0067] of EP'237) overlap the composition

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ranges of the instant invention, which is a prima facie case of obviousness. SEE MPEP 2144.05 I. Because both JP'248 and EP'237 teach the same ferritic Cr-containing steel sheet, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the alloy with the claimed composition of Cr, C, Si, Mn, Ni, Mo, Cu, N, Ti, Nb, V, and Fe from the composition disclosed by EP'237 to manufacture the spring elements of JP'248 because JP'248 and EP'237 disclose the same utility throughout the disclosed ranges.

Element	From instant Claim 1 (in wt%)	EP'237 (in wt%)	Overlapping range (in wt%)
C	0.03-0.12	0.001-0.12	0.03-0.12
Cr	13-20	11-18	13-18
Si	0.2-0.9	0-1.0	0.2-0.9
Mn	0.3-1	0-1	0.3-1
Ni	0-0.5	0-1	0-0.5
Mo	0.1-2	0.5-2.5	0.5-2
Cu	0.05-1.0	0.5-2.5	0.5-1.0
N	0.02-0.5	0.01-0.12	0.02-0.12
Ti	0-0.01	Optional 0.05-0.5	0
Nb	0.01-1.0	Optional 0.05-0.5	0.01-0.1
V	0.02-0.25	0-0.15	0.02-0.15
Fe	Balance	Balance	Balance

Regarding claims 7-9, the damping performance (Claims 7-8) and magnetic hardness (Claim 9) are specific properties of the alloy. Because JP'248 in view of EP'237 teaches the similar ferritic stainless steel as recited in the instant invention as discussed in the rejections for the claims 1-3, the specific

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properties, for example, the claimed damping performance (Claims 7-8) and magnetic hardness (Claim 9) would be inherently obtained in JP'248 in view of EP'237. See MPEP2112 III&IV. Regarding the process limitation in the instant claims 7-9, EP'237 further teaches cold rolling and annealing operations, which read on annealing and cold forming operations as recited in the instant claims, for example, retention operation at 900 to 1050°C for 1 to 2 min. (Paragraphs [0116] and [0126] of EP'237), which is within the heating condition range of 0.5 to 60 min. at temperature of 900 to 1100°C as recited in the instant claim 7; 75% to 80% deformation (paragraph [0116] and [0126] of EP'237) overlaps the over 65% deformation range as recited in the instant claim 8. JP'248 teaches a post-heat treatment (300 to 600°C) (Fig.3 of JP'248), which overlaps the 200 to 380°C of tempering temperature range as recited in the instant claim 9.

Regarding claim 4, coercive force and magnetic saturation are properties that are dependent on alloy composition and heat treatment process. As discussed in the rejections for the claims 1-3 and 7-9, JP'248 in view of EP'237 teaches the similar stainless steel with the compositions ranges overlap the composition ranges of the claimed alloy, and the similar heat treatment processes as recited in the application's disclosure,

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the specific properties like coercive force and magnetic saturation would be inherently obtained in the spring element of JP'248 in view of EP'237. See MPEP 2112.III&IV.

Claims 5-6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'248 in view of EP'237 as applied in claims 1-4, 7-9 and further in view of Baba (JP 60-213246, thereafter JP'246).

Regard to claims 5-6, and 10, JP'248 in view of EP'237 does not explicitly state applying a thermosetting powder coating on a spring element. JP'246 teaches a thermosetting powder coating on leaf spring with thermally curing to enhance the heat resistance and the wear resistance (Abstract of JP'246) and the thickness of coating film from 0.01 to 1 mm (Page 216, 4<sup>th</sup> paragraph), more specifically, 0.1 mm film and curing at 200°C for 60 min.(example 1 of JP'246). Film thickness and curing temperature within the thickness and curing temperature range recited in the instant claims. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a thermosetting powder coating as demonstrated in JP'246 on the spring element of JP'248 in view of EP'237 in order to enhance the heat resistance and the wear resistance (Abstract of JP'246).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/

Supervisory Patent Examiner, Art Unit 1793